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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/329,461	06/10/1999	HERMAN RODRIGUEZ	AT9-99-085	8120

35525 7590 08/29/2005

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EXAMINER

NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/329,461	RODRIGUEZ ET AL.	
	Examiner	Art Unit	
	CUONG H. NGUYEN	3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4,27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,4,27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of the Claims

1. Claims 3-4, and 27-28 are pending based on the Appeal Brief filed on 1/12/2005.

Response to Applicant's Arguments

2. After reviewing carefully pending claims and cited references, on 6/08/2005 the Appeal Conferees (including the examiner's SPE) want to re-open this case's prosecution since cited reference of Tognazzini meets all limitations of claims 3-4 for 35 USC 102(b) rejections (according to reasonable interpretation), and also this reference meets all limitations of independent claim 27-28 for a 35 USC 103(a) rejection. This rationale would help the Appeal Court to make a quick decision rather than 35 USC 103(a) rejections (in Office Action 10/12/2004).

The applicants argue that: the claims recite "providing inventory records corresponding to a plurality of products for sale" (4/08/2003). Although the applicants "believe" that Tognazzini's "inventory records" corresponding to the sales transactions, not to the product themselves, the examiner's position is that it also means both "physical product" and transactions because they are delivered to the buyer's possession after all; saying "sale transactions" is similar to "sold product" because they are no longer being owned by the seller – the ownership of a product has been transferred. The applicants also argue that Tognazzini does not disclose updating the records when the product delivered; however, this claimed feature is inherently existed with the software that operating on the "cash-register" even Tognazzini does not disclose because when talking about "inventory records" one with ordinary skill in the art understands that means "currently available product".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 3-4 are rejected under 35 U.S.C. § 102(b) as being anticipate by

Tognazzini (US Pat. 5,739,512).

A. As per independent claim 3: Tognazzini teaches a method for maintaining

inventory records of products being sold (see Tognazzini, col.2, lines 62-65 wherein

producing a report is producing an inventory record), comprising:

- providing inventory records corresponding to products for sale (“to produce a report” is similar to “produce an inventory record”, see Tognazzini, col.2, lines 64-65);
- processing a purchase transaction for a product (i.e., on computer/cash-register or “deliver” a product, see Tognazzini, Fig.4);
- generating an electronic receipt comprising data concerning the purchase transaction (see Tognazzini, Fig.1, ref.100; and Fig.8, ref. 850);
- storing said electronic receipt on a removable storage medium (i.e., a computer’s floppy disk, see Tognazzini, Fig.7, ref. 730)
- at a different time (i.e., reviewing one second later), reading said electronic receipt from said removable storage medium sale (see Tognazzini, col.2, lines 62-65);
- validating said electronic receipt sale (see Tognazzini, col.5, lines 1-10); and in response to validating said electronic receipt: providing an indication to proceed with a *delivery* of said product sale (this action is inherent in Tognazzini); and updating an inventory record corresponding to said first product to reflect the delivery of said first

Serial Number: 09/329,461
Art Unit 3661

product (the claimed phrase “the delivery of said first product” is reasonably interpreted as “a transaction is executed”, see Tognazzini col. 2, lines 62-65).

B. As per dependent claim 4: Tognazzini teaches about authenticating/inspecting a digital signature (for verification - see Tognazzini, col.5, lines 2-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 27-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tognazzini (US Pat. 5,739,512).

Tognazzini further teaches a computer program product in a computer readable medium (see Tognazzini, col. 3, lines 39-45) for processing an electronic receipt (see Tognazzini, col. 2, lines 17-67).

Tognazzini does not expressly disclose about a computer program product for maintaining inventory records comprising instructions that perform above steps of claims 3-4.

However, the examiner’s position is Tognazzini uses computer instructions to direct the computer to perform all of the actions/steps identified supra with the system disclosed in Figs. 1-2, and as specifically claimed in claims 27 and 28.

It would have been obvious for one of ordinary skill in the art at the time of invention to implement Tognazzini’s idea to expressly disclose a computer program product such as a floppy disk, a smart card, a hard drive containing operating instructions, for operating Tognazzini’s system as shown in Figs. 1-2, verifying a receipt, and maintaining inventory records comprising instructions that perform above-analyzed steps

Serial Number: 09/329,461
Art Unit 3661

of claims 3-4 because it is widely recognized the advantage of automation manual steps for repetition uses on a computer-executable portable medium.

Conclusion

5. Claims 3-4, and 27-28 are not patentable.

6. These references are considered pertinent to this application:

- Business Wire, Feb 11, 1999; RPK Security Selected to Provide Encryption Solution for Electronic Payment Systems and Smart Card Readers. (claim 46)

- Digital signature reaches new level.(Bank of Nova Scotia uses Entrust Technologies' public key infrastructure software) (Company Operations); (Author: Greg Meckbach. Issue: June 22, 1998).

- **Trotta, Jr.**, (US Pat. 5,595,264), System and method for automated shopping - 1/21/1997; wherein a system and method of automated shopping, including a portable bar code scanner for scanning bar code indicia information on items selected to be purchased, securing the scanner in a holder for limited access, and releasing the portable bar code scanner upon receiving an authorized payment card. A plurality of items for purchase are displayed in a store such that a customer can select an item to be purchased from the store display. The customer scans the bar code indicia on the selected item from the store display. The payment card is debited for the purchase price of the selected item and then returned to the customer.

- **Kitagawa et al.** (US Pat. 6,032,857 – 8/23/1994) Electronic money system wherein an electronic money system has an IC card for electronic money having a memory for maintaining money deposit and money debit information and another memory, such as an EPROM, for storing transaction data, including detailed information of transactions, such

Serial Number: 09/329,461
Art Unit 3661

as the content of a typical receipt received from a retail store. The transaction information can be used at a later time in a personal computer so that an electronic record of household expenses can be maintained. The transaction data that is stored includes the product name, price of the product, quantity of the product purchased and similar details of the transaction. The IC card memory can record the name and telephone number of a retail store where the card has been used or a network address can be recorded in the memory for use by a customer to access electronic direct-mail information by using a PC. Also, a store can determine whether a particular purchase is within a range of average purchases in terms of the number of products being purchased in a transaction and the total cost of the transaction, based on the stored transaction information.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759. The examiner can normally be reached on 7:30 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6759.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Serial Number: 09/329,461
Art Unit 3661

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.


CUONG H. NGUYEN
Primary Examiner
Art Unit 3661